

REMARKS

Claims 1 – 83 are pending in the present application. No claims were amended, cancelled, or added, leaving Claims 1 – 83 for consideration. Reconsideration and allowance of the claims is respectfully requested in view of the following remarks.

Obviousness-type Double Patenting

Claims 1 – 83 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over Claims 51 – 75 of copending Application No. 11/102,068 (hereinafter the ‘068 Application). Applicants respectfully traverse this rejection. However, since neither the present claims nor the claims of the ‘068 Application, have been patented, there is no way that double patenting can be determined (nothing is patented and there is no way to compare the final claims until one of the cases has been patented and the other claims are otherwise allowable). Hence, the Applicants respectfully request that the Examiner withdraw this obviousness double patenting rejection until the claims are in final form and otherwise in condition for allowance, and the case over which double patenting is alleged is allowed. Until such time, there is no double patenting and no way to determine double patenting.

It is further note, that the present claims are non-obvious over the art of record, as is explained below. Also, If the “provisional” double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent...” (MPEP 804.01.I(B))

Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1 - 83 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,183,829 to Daecher et al. Applicants respectfully traverse this rejection.

The present claims are directed to, for example, a storage media, comprising: a plastic substrate, an optical layer having a layer composition different from the substrate composition, a data storage layer disposed therebetween, and a reflective layer disposed between the data storage

layer and the substrate. The storage media has a radial deviation over time of less than or equal to about 1.15 degrees at a radius of 55 mm when exposed to humidity. (Claim 1)

Daecher et al. are directed to process and apparatus for forming plastic sheet, and in particular, to an optical storage medium comprising one or more layers of plastic sheet, a reflective or semireflective layer, and a protective layer. (Title, Col. 2, lines 29 – 41) They mention that the process can be used with any *suitable* plastic resin, and preferably thermoplastic resins. (Col. 13, line 66 – Col. 14, line 1) It is therefore alleged that “[u]se of layers of different resins would have the same effect and supplement each other... Such a resin laminate would inherently achieve the claimed radial deviation...” (Office Action dated August 23, 2006, hereinafter “OA 08/06”, page 2)

Obviousness is not based upon what an artisan *could do* or what an artisan *may try*, but is based upon what an artisan would be *motivated to do with an expectation of success*. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, No. 04-1616 (CAFC March 22, 2006) citing *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); and *In re Rouffett*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998). Merely because an artisan *could try* different resins for the layers of the sheet is not motivation or an expectation of success.

It is noted in OA 07/06 that the use of different resins “would have the same effect and supplement each other”. Applicants respectfully disagree with this statement. It is merely an unsupported conclusory statement with no basis in technical reasoning. The random use of “different resins” would not necessarily be expected by an artisan to “have the same effect”, or to “supplement each other”. There are many issues that would be considered by an artisan, such as adhesion between the layers, compatibility of the layers, optical properties, mechanical properties, etc. One resin does not automatically “have the same effect” as another resin. Additionally, merely because materials are resins does not mean that they will supplement each other or that they will even be compatible.

It is also alleged that

such a resin laminate would inherently achieve the claimed radial deviation (see first two lines of paragraph [0074] in applicants' specification). The experimental modification of this prior art in order to ascertain optimum operating conditions... fails to render applicants' claims patentable...

(OA 08/06, page 2) Firstly, Paragraph [0074] states: "The storage media disclosed herein reduces radial tilt by mismatching the compositions of the optical film and substrate, and by optionally employing mis-matched thicknesses of the substrate and optical film." It does not state that every single combination of layers forming a substrate, if mis-matched, will attain the claimed deviation.

Secondly, inherency only happens if the elements (1) are necessarily present and (2) one of ordinary skill in the art recognize or appreciate the inherent element. See, e.g., *Galaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1046 (Fed. Cir. 1995). Moreover, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Continental Can Co. v. Monsanto*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (*reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art*); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). No basis in technical reasoning as to the inherent presence of the claimed characteristic has been provided.

Finally, it is noted that OA 08/06 refers to the layers of the sheet on which the reflective layer is disposed. It does not refer to mis-match between the substrate composition and the optical layer with a reflective layer disposed therebetween. Hence, even modified as suggested in OA 08/06, Daecher et al. fail to teach all of the elements of the present claims. Therefore, Daecher et al. fail to render the present claims obvious.

For at least the reasons provided above, Daecher et al. fail to render the present claims obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections under 35 U.S.C. §112 (first paragraph)

Claims 1 – 18, 21, - 34, 36 – 44, 46, 48 – 58, 62 – 69, 71 – 75, and 80 – 82, have been rejected under 35 U.S.C. §112 (first paragraph) as allegedly being broader than the enabling disclosure as a result of applicants' failure to recite that the optical layer is made of plastic material. Applicants note, firstly, that Claim 1 does not state that the optical layer is a plastic, but merely states that the composition is different than the substrate composition. Additionally, the specification states "optical layer or optical film"; "The film is the optical medium and the information layer is on the ...substrate. These thin optical mediums can be thought of as optical films." (Paragraph [0027]) The specification then continues to explain that

Possible optical film materials that can be any plastic that exhibits appropriate properties, including thermoplastics, thermosets, as well as homopolymers, copolymers, reaction products, and combinations comprising at least one of the foregoing materials...

(Paragraph [0039]) Additionally, subsequent paragraphs provide many details on some possible specific materials. Hence, the specification does state that the optical layer can be a plastic material. Reconsideration and withdrawal of this rejection are respectfully requested.

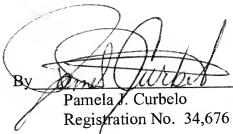
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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the rejection(s) and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Response or otherwise, please charge them to Deposit Account No. 50-1131.

Respectfully submitted,

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